

REMARKS

The Amendment After Final is submitted in response to the Office Action dated June 3, 2004. In the Office Action, the Patent Office rejected Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 4 of U.S. Patent No. 6,089,613 to *Petkovsek* in view of PAP US 2002/0103697 to *Lockhart et al.* Further, the Patent Office rejected Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,782,494 to *Crandall et al.* in view of *Lockhart et al.* Moreover, the Patent Office rejected Claims 3-7 under 35 U.S.C §103(a) as being unpatentable over *Crandall et al.* in view of U.S. Patent No. 6,241,844 to *Petkovsek*.

By the present amendment, Applicant amended Claim 1. Applicant asserts that the application is in condition for allowance in view of the amendment to Claim 1 and for the reasons that follow. Notice to that effect is requested.

With respect to the rejection of Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 4 of *Petkovsek* in view of *Lockhart et al.*, Applicant submits that this rejection has been overcome in view of the amended claim and for the reasons that follow.

In the Office Action, the Patent Office asserts:

Lockhart et al. discloses in Fig. 8, a form comprising an electronically imaged postage accessed over a global network

In regards to Claim 1, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

However, Claim 1, as amended, requires a first part which receives a first type of electronically-imaged postage accessed over a global computer network wherein a second part receives a second type of electronically-imaged postage accessed over a global computer network. Further, Claim 1 requires that one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service. Moreover, Claim 1 requires that one of the first part or the second part is removable from the front side of the first layer and attaches to the mailpiece to effect the delivery of the mailpiece by the special service.

Lockhart et al. teach a method for generating and distributing mail items which includes creating a first and a

second mail file. Further, *Lockhart et al.* teach that the first and second mail files are then transmitted to a mail service computer over a global computer network and printed as a first mail item in accordance with the first mail file and a second mail item in accordance with the second mail file. Moreover, *Lockhart et al.* teach that the first and second mail items are then placed into a surface mail system and are then delivered to the postal addresses of the intended recipients.

Petkovsek teaches a label/form which is provided for attaching portions thereof to a mailpiece or shipping item particularly for special service handling of the mailpiece or shipping item.

However, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a first part which receives a first type of electronically-imaged postage accessed over a global computer network wherein a second part receives a second type of electronically-imaged postage accessed over a global computer network as required by Claim 1. Further, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service as required by Claim 1. Still further, neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or

suggest one of the first part or the second part is removable from the front side of the first layer and attaches to the mailpiece to effect the delivery of the mailpiece by the special service as required by Claim 1.

The Patent Office admits that "*Petkovsek* does not disclose a first part which receives electronically-imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece and a second part which receives electronically-imaged postage accessed over a global computer network necessary to effect delivery of a mailpiece." Further, none of the plurality of parts of the form taught by *Petkovsek* receive electronically-imaged postage. Contrary to the assertions of the Patent Office, *Lockhart et al.* merely teach that "the static data includes portions of the finished mail item which does not change significantly from card-to-card (e.g., template information, logos, postage information, and the like)." Furthermore, *Lockhart et al.* do not teach or suggest a form having postage of the special service wherein the postage is necessary to effect the delivery of the mailpiece by the special service as required by Claim 1.

An obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide

unjustified extension of the term of the right to exclude granted by a patent. Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001).

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the non-obviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991).

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998).

Neither *Petkovsek* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a form having one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service wherein one of the first

part or the second part is removable from the front side of the first layer and attaches to the mailpiece to effect the delivery of the mailpiece by the special service as required by Claim 1. Furthermore, a person of ordinary skill in the art would never have been motivated to modify the teachings of *Petkovsek* with *Lockhart et al.* in the manner suggested by the Patent Office in formulating the rejection under the judicially created doctrine of obviousness-type double patenting. Accordingly, the rejection of Claims 1-7 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1 and 2 under 35 U.S.C. §103(a) as being unpatentable over *Crandall et al.* in view of *Lockhart et al.*, Applicant submits that this rejection has been overcome in view of the amendment to Claim 1 and for the reasons that follow.

In the Office Action, the Patent Office asserts:

Lockhart et al. disclose in Fig. 8, a form comprising a electronically imaged postage accessed over a global network wherein the image postage can be sized and the form can be printed.

In regards to Claim 1, wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

In regards to Claim 1, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically imaged information is necessary to effect the deliver of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the first and second part is sized to correspond to electronically imaged postage, since Applicant has not set forth the dimensional parameters of the electronically imaged postage.

Crandall et al. teach a printer note construction consisting of repositionable adhesive coated (discontinuously) substrates removably affixed onto a backsheet, such that the construction can pass through a personal computer printer without damage to the printer or to the article.

Neither *Crandall et al.* nor *Lockhart et al.*, taken singly or in combination, teach or suggest a first part which receives a first type of electronically-imaged postage accessed over a global computer network wherein a second part receives a second type of electronically-imaged postage accessed over a global computer network as required by Claim 1. Further, neither *Crandall et al.* nor *Lockhart et al.*, taken singly or in combination, teach or suggest one of the first type of

electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service as required by Claim 1. Still further, neither *Crandall et al.* nor *Lockhart et al.*, taken singly or in combination, teach or suggest that one of the first part or the second part is removable from the front side of the first layer and attaches to the mailpiece to effect the delivery of the mailpiece by the special service as required by Claim 1.

The Patent Office admits that "*Crandall et al.* do not disclose the plurality of parts which receive electronically-imaged postage accessed over a global computer network wherein the electronically-imaged information is necessary to effect the delivery of the mailpiece wherein the first part is sized to correspond to a first type of electronically-imaged postage and the second part is sized to correspond to a second type of electronically-imaged postage." Contrary to the assertions of the Patent Office, *Lockhart et al.* merely teach that "the image side 1102 preferably includes various preprinted elements such as a logo graphic 1108, a postage marking 1110, and a "return service requested" indicator 1112."

Moreover, a person of ordinary skill in the art would never have been motivated to modify the teaching of *Crandall et al.* with *Lockhart et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Applicant

submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's form to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Even assuming that one having ordinary skill in the art could somehow have modified *Crandall et al.* with *Lockhart et al.* as set forth by the Examiner, the resultant modification still lacks the critical features and structural relationships. Namely, *Crandall et al.* and *Lockhart et al.* lack a first type and a second of electronically-imaged postage wherein one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service positively recited in Claim 1. Moreover, *Crandall et al.* and *Lockhart et al.* lack a first part or a second part which is removable from the front side of the first layer and attaches to the mailpiece to effect the delivery of the mailpiece by the special service positively recited in Claim 1. Therefore, the rejection of Claim 1 under 35 U.S.C §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Final Office Action, the Patent Office asserts that the first and second part which is sized to correspond to electronically imaged postage does not result in a structural difference between the claimed invention and the prior art since Applicant has not set forth the dimensional parameters of the electronically imaged postage. Applicant submits, however, that a first part which receives a first type of electronically-imaged postage and a second part which receives a second type of

electronically-imaged postage structurally limits Claim 1. Further, Applicant submits that the present invention, as defined in Claim 1, requires that one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service and, therefore, structurally limits Claim 1. More specifically, the present invention, as defined in Claim 1, specifically sets forth a form which requires that one of the first type of electronically-imaged postage or the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service, in fact, structurally limits Claim 1 and patentably distinguishes the claimed invention defined in Claim 1 from the art of record.

Claims 2-7 depend from independent Claim 1. These claims are also believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional structural elements of Applicant's form for delivery of a mailpiece by a special service. Notice to that effect is requested.

In view of the foregoing remarks and amendment, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither

further search nor consideration would be necessitated by entry of this Amendment; therefore, entry of this Amendment is proper and should be effected.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

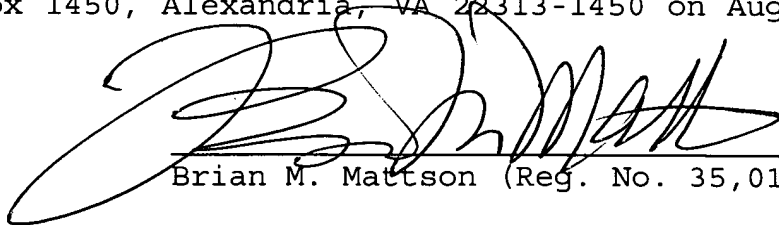


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CERTIFICATE OF MAILING

I hereby certify that this **Amendment After Final** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 3, 2004.

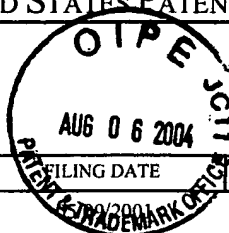


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/852,184

7590

06/03/2004

Glenn Petkovsek

USA-P-00-001

4886

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/03/2004

PATENTS+TMS

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,184

Applicant(s)

PETKOVSEK, GLENN

Examiner

Mark T Henderson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim 1 has been amended for further examination.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 are finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,089,613 (Petkovsek) in view of PAP US 2002/0103697 (Lockhart et al).

Petkovsek discloses in Claims 1 and 4, a form having: a first layer made up of a plurality of parts with a front side and a backside, wherein the front side receives indicia, and the backside

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comprises removable adhesive; and a second layer having a front side with a non-adhesive layer; wherein one of the plurality of parts receives special service mail information, sender information, and recipient information; a post card section.

However, Petkovsek does not disclose; wherein a first part of the plurality of parts receives an electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; and a second part receives a second type of electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; wherein the first part is sized to correspond to a first type of electronically-imaged postage; and wherein the second part is sized to correspond to a second type of electronically-imaged postage.

Lockhart discloses in Fig. 8, a form comprising a electronically imaged postage accessed over a global network.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's form to include electronically imaged indicia as taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the first and second part is sized to correspond to electronically imaged postage, since applicant has not set forth the dimensional parameters of the electronically imaged postage; and further wherein the electronically imaged information is capable of effecting the delivery of the mailpiece. Furthermore, the electronically imaged postage can be accessible by a first and second provider.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 2 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Crandall et al (5,782,494) in view of Lockhart et al.

Crandall et al discloses a form comprising: a first layer (21) having a front side (26) and a back side (22) wherein the front side has a plurality of parts (various sections divided by die-cut)

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which receive indicia; a second layer (25) having a front side (A) with a non-adhesive layer (Col. 5, lines 4-17), wherein the plurality of parts are removably secured (by adhesive 27).

However, Crandall et al does not disclose: wherein the plurality of parts receive electronically imaged postage accessed over a global network wherein the electronically image information is necessary to effect the delivery of the mailpiece; and wherein the first part is sized to correspond to a first type of electronically-imaged postage; and wherein the second part is sized to correspond to a second type of electronically-imaged postage.

Lockhart discloses in Fig. 8, a form comprising a electronically imaged postage accessed over a global network, wherein the image postage can be sized and the form can be printed.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Crandall et al's form to include electronically imaged indicia as taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. Therefore, the first and second part is sized to correspond to electronically imaged postage, since applicant has not set forth the dimensional parameters of the electronically imaged postage; and further wherein the electronically imaged information is capable of effecting the delivery of the mailpiece.

Furthermore, the electronically imaged postage can be accessible by a first and second provider.

4. Claims 3-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Crandall in view of Petkovsek (6,241,844).

Crandall et al discloses a form comprising all the elements as claimed in Claim 1, and as set forth above. However, Crandall et al does not disclose: wherein one of the plurality of parts receives: a section which receives special mailing service information, sender information and recipient information; and a postcard subsection.

Petkovsek discloses in Fig. 1, a form comprising a plurality of parts or sections which can receive special service information, sender information, and recipient information (Col. 5, lines 1-16), and a postcard subsection (13).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Crandall et al's form to include mailing information as taught by Petkovsek for the purpose of tracking an article upon which the form parts are applied.

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Response to Arguments

5. Applicant's arguments filed on March 18, 2004 have been fully considered but they are not persuasive.

In regards to applicant's arguments that neither the Petkovsek or Lockhart et al taken singly or in combination, "teach or suggest a form for delivery of a mailpiece by a special service having a first part which is sized to correspond to a first type of electronically-imaged postage accessed over a global computer network and having a second part which is sized to correspond to a second type of electronically-imaged postage accessed over a global computer network", the examiner submits that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Petkovsek discloses a form having: a first layer made up of a plurality of parts with a front side and a backside, wherein the front side receives imaged indicia, and the backside comprises removable adhesive; and a second layer having a front side with a non-adhesive layer; wherein one of the plurality of parts receives special service mail information, sender information, and recipient information; a post card section. However, Petkovsek does not disclose; wherein a first part of the plurality of parts receives an electronically imaged postage accessed over a global computer

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network necessary to effect delivery of the mailpiece; and a second part receives a second type of electronically imaged postage accessed over a global computer network necessary to effect delivery of the mailpiece; wherein the first part is sized to correspond to a first type of electronically-imaged postage; and wherein the second part is sized to correspond to a second type of electronically-imaged postage.

Lockhart discloses in Fig. 8, a form comprising a electronically imaged postage (1110) accessed over a global network; wherein the image can be sized and the form can printed (Page 8, Par. 110 and 112).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's form to include electronically imaged indicia as taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the first and second part is sized to correspond to electronically imaged postage, since applicant has not set forth the dimensional

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parameters of the electronically imaged postage; and further wherein the electronically imaged information is capable of effecting the delivery of the mailpiece. Furthermore, the electronically imaged postage can be accessible by a first and second provider.

In regards to applicant's argument that the Crandell et al does not disclose "a plurality of parts which receive electronically-imaged postage accessed over a global computer network wherein the electronically-imaged information is necessary to effect the delivery of the mailpiece", the examiner submits that in this case, Crandell et al discloses a form comprising: a first layer having a front side and a back side, wherein the front side has a plurality of parts (various sections divided by die-cut) which receive imaged indicia; and a second layer having a front side with a non-adhesive layer, wherein the plurality of parts are removably secured.

However, Crandall et al does not disclose: wherein the plurality of parts receive electronically imaged postage accessed over a global network wherein the electronically image information is necessary to effect the delivery of the mailpiece; and wherein the first part is sized to correspond to a first type of electronically-imaged postage; and wherein the second part is sized to correspond to a second type of electronically-imaged postage. The Lockhart et al reference is now used to disclose a form comprising a electronically imaged postage accessed over a global network, wherein the image postage can be sized and the form can be printed.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Crandall et al's form to include electronically imaged indicia as

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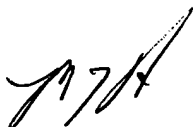
taught by Lockhart et al for the purpose of allowing a user to cost-effectively create and distribute individualized surface mailings using an easy to use computer interface available over the Internet.

In regards to **Claim 1**, wherein the first and second part are sized to correspond to a first and second type of electronically imaged postage; and wherein the electronically image information is necessary to effect the delivery of the mailpiece, and is accessible by a first and second provider, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the first and second part is sized to correspond to electronically imaged postage, since applicant has not set forth the dimensional parameters of the electronically imaged postage; and further wherein the electronically imaged information is capable of effecting the delivery of the mailpiece. Furthermore, the electronically imaged postage can be accessible by a first and second provider.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

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